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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,037	10/31/2003	Robert L. Cobene II	200300643-1	8371

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HEWLETT PACKARD COMPANY  
P O BOX 272400, 3404 E. HARMONY ROAD  
INTELLECTUAL PROPERTY ADMINISTRATION  
FORT COLLINS, CO 80527-2400

EXAMINER
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GATES, ERIC ANDREW

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 10/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/697,037

Applicant(s)

COBENE ET AL.

Examiner

Eric A. Gates

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
- 4a) Of the above claim(s) 42-71 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 11, 12, 15, 19, 22, 32, 33, 36 and 39 is/are rejected.
- 7) ☒ Claim(s) 2-10, 13, 14, 16-18, 20, 21, 23-31, 34, 35, 37, 38, 40, and 41 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/31/03, 4/18/06</u>   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of invention I, claims 1-41, in the reply filed on 5 June 2006 is acknowledged.
2. Claims 42-71 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 5 June 2006.

### *Drawings*

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 116, 118, 120a, and 120b. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective

Art Unit: 3722

action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

4. The attempt to incorporate subject matter into this application by reference to the method of calculating surface energy following the method of Owens and Wendt is ineffective because the calculations are not included in the specification, only a summary of the values obtained from the calculations.

The incorporation by reference will not be effective until correction is made to comply with 37 CFR 1.57(b), (c), or (d). If the incorporated material is relied upon to meet any outstanding objection, rejection, or other requirements imposed by the Office, the correction must be made within any time period set by the Office for responding to the objection, rejection, or other requirement for the incorporation to be effective. Compliance will not be held in abeyance with respect to responding to the objection, rejection or other requirement for the incorporation to be effective. In no case may the correction be made later than the close of prosecution as defined in 37 CFR 1.114(b), or abandonment of the application, whichever occurs earlier.

Any correction inserting material by amendment that was previously incorporated by reference must be accompanied by a statement that the material being inserted is the material incorporated by reference and the amendment contains no new matter. 37 CFR 1.57(f).

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 5, 21, and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 5 recites the limitation "or a combination thereof". It is unclear how the previous limitations of the claim are to be combined.

8. Claims 21 and 41 recite the limitation "wherein calculations for surface energy follow the method of Owens and Wendt." It is unclear how this limitation defines the metes and bounds of the claim, as the method of Owens and Wendt is not included in the disclosure.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 3722

10. Claims 1, 11, 12, 15, 19, 22, 32, 33, 36, and 39 are rejected under 35

U.S.C. 102(e) as being anticipated by Lawton (U.S. Patent Publication 2003/0086773 A1).

11. Regarding claim 1, Lawton discloses a method of binding a text body to a cover 104 with an adhesive to form a bound document, the method comprising: applying an adhesive 110 to a contacting surface of a plurality of sheets 102 of the text body on an individual sheet-wise basis; and adhering the plurality of sheets to the cover 104 on an individual sheet-wise basis by making line contact between the contacting surface and the cover and by curing (pressing activates the adhesive and forms a cohesive bond) the adhesive (see paragraphs [0043] to [0045] and [0060] to [0061], and figures 8 and 9).

12. Regarding claim 11, Lawton discloses wherein the plurality of sheets 102 includes an unfolded sheet and the contacting surface is an edge of the unfolded sheet (see figure 8).

13. Regarding claim 12, Lawton discloses constraining the sheet 102 to maintain the edge straight (using alignment system 120, see figure 8).

14. Regarding claim 15, Lawton discloses wherein the contacting surface makes line contact with the cover 104 in an area of a spine 106 of the bound document (see figures 8 and 9).

15. Regarding claim 19, Lawton discloses forming the cover around the text body (see figures 8 and 9).

Art Unit: 3722

16. Regarding claim 22, Lawton discloses wherein the applied adhesive 110 is a first part of a two-part adhesive system and the method comprises applying a second part 108 of the two-part adhesive system to the cover 104 prior to adhering the plurality of sheets to the cover on an individual sheet-wise basis (see figures 8 and 9).

17. Regarding claim 32, Lawton discloses wherein the plurality of sheets 102 includes an unfolded sheet and the contacting surface is an edge of the unfolded sheet (see figure 8).

18. Regarding claim 33, Lawton discloses constraining the sheet 102 to maintain the edge straight (using alignment system 120, see figure 8).

19. Regarding claim 36, Lawton discloses wherein the contacting surface makes line contact with the cover 104 in an area of a spine 106 of the bound document (see figures 8 and 9).

20. Regarding claim 39, Lawton discloses forming the cover around the text body (see figures 8 and 9).

***Allowable Subject Matter***

21. Claims 2-10, 13, 14, 16-18, 20, 21, 23-31, 34, 35, 37, 38, 40, and 41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 3722

**Conclusion**

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric A. Gates whose telephone number is 571-272-5498. The examiner can normally be reached on Monday-Thursday 7:45-6:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



EAG  
3 October 2006



MONICA CARTER  
SUPERVISORY PATENT EXAMINER